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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,512	01/22/2001	William Vong	MS1-155USC3	3413

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EXAMINER

SHIN, CHRISTOPHER B

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 01/20/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,512

Applicant(s)

VONG ET AL.

Examiner

Christopher B Shin

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-20, 23 and 41-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-20, 23 and 41-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The Amendment received September 30, 2003 & November 7, 2003 has been entered and carefully considered. Claims 18-20, 23 & 41-46 are pending in the application.

Claim 40 & 47 raises potential Double Patenting rejection against the Parent Patent(s), if the claims 40 & 47 are considered. The examiner notes that the earlier parent applications had restrictions requirements including the above subject matter.

Response to Arguments

2. Applicant's arguments filed September 30, 2003 have been fully considered but they are not persuasive for the following reasons.

a. On page 7, lines 3-15, as for the claim 18, the examiner disagrees with the applicant's interpretations of the claimed invention. By looking at the figure 1, instead/verses of figure 8, one can interpret the claimed "ends" & surfaces" different from the applicant, when the screen portion/section/lid (3) is opened. In other words, one can interpret "ends" being surfaces of (8/8b) of figure 1. With the above interpretations, the teachings of the Seto anticipates, not clearly anticipates, (reads on the Seto reference) the present claimed invention. One can also see the limitations regarding the wrap around and raised teachings from figure 1 of the Seto reference, when given the above interpretations. Furthermore, when it come to the functionality of the claimed limitations, the Seto clearly teaches all of the claimed "activated upon a occupance of an event to notify a user" function.

b. On pages 7-10, as for the claims 19, 20 & 42-44 the above examiner's broad interpretation and discussions are similarly applied.

c. On pages 11-12, as for the claim 23, the examiner disagrees with the applicant's argument regarding the "designer's choice" argument, as can be seen from the Secondary references Weber, Wunsch & Maddrell, One can easily recognize the commonly utilized type of LED integrated button for activation, deactivation & event notification claimed functions for the

design choice substitution without having any differences in terms of performing/supporting or teaching the claimed combination limitations.

d. On pages 12-13, as for the claims 41 & 45-46, the above discussions (e.g., paragraph 2a-2c are similarly applied.

e. The examiner suggests the applicant to carefully review all of the Examiner cited references before responding to this office action. The examiner relies on the cited art for the well known prior art/common knowledge/support of the official notice.

f. In summary, the examiner believes that the arguments between the applicant and the examiner caused by the difference in the interpretations of the present claims & the teachings of the cited references. Therefore, the examiner suggests the applicant carefully consider the possible, more broad, interpretations that can be applied to the claims and the teachings of cited references.

For the above reasons, the examiner maintains the art rejection as follows.

Establishment of Well Known Prior Art

3. Examiner would like to establish that LED (light emitting diode/device) are well known as being one of the common elements in the portable computer environment (supported by Paulick 6,018,584 and many more in the art). Furthermore, the color, shape, size, and location of such LED is clearly within the choice of the designer, as supported by the examiner cited prior art of record and more not yet cited but the examiner would like give official notice on such well known design choices. In addition, in most cases, the LEDs are used to notify the user of a certain event or condition to a user. For example, every laptop, handheld/palm top, desk top, and main frame, peripherals, and more usually have one or more LEDs to indicate conditions or notify the user events. The examiner also give official notices on such well known common knowledge. For the above reasons, the examiner strongly believes that the present claimed inventions are not allowable over the prior art of record. There are many prior art teaches the claimed functional equivalent of notifying events from multiple direction due to a physical shape/design of LEDs.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 18-20 and 42-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Seto et al (5,552,967).

The Seto reference teaches all of the factional equivalent claimed limitations as follows:

Claim 18

Seto et al.

- portable handheld computing device comprising
 - feature of figure 1
- casing having upper and lower surfaces, opposing front and back side surfaces, and opposing end surfaces, the ends being dimensionally shorter than the from and back side surfaces
 - feature of figure 1
- light emitting device (LED) mounted externally on the casing, the LED being positioned on the upper surface and wrapping around to and being raised on one of the end surfaces
 - feature (254)
- LED being activated upon occurrence of an event to notify a user
 - inherent feature of (254)

Claim 19

Seto et al.

- portable handheld computing device comprising
 - feature of figure 1
- casing having a base and a lid
 - feature of figures 1 & 8

- the LED being activated upon occurrence of an event to notify a user
 - inherent feature of (254)

Claim 20 Seto et al.

- portable handheld computing device comprising
 - feature of figure 1
- casing having a base and a lid that opens and closes relative to the base
 - feature of figures 1 & 8
- the lid having an upper surface, opposing side surfaces, and opposing end surfaces
 - figure of figure 8
- LED device mounted externally on the casing
 - feature of figures 1 & 8
- LED being activated upon occurrence of an event to notify a user
 - inherent feature of (254)
- positioned on the upper surface of the lid, and wrapping around to one of the end surfaces so that the LED is visible from both opposing side surfaces and both opposing end surfaces when the lid is opened or closed
 - feature of figures 1 & 8

Claims 42-44 Seto et al.

- portable handheld computing device comprising
 - feature of figure 1
- casing having upper and lower surfaces, opposing front and back side surfaces, and opposing end surfaces
 - feature of figure 1
- LED device mounted externally on the casing
 - feature of figures 1 & 8
- LED being activated upon occurrence of an event to notify a user
 - inherent feature of (254)
- positioned such that the LED is visible from both opposing side surfaces and one of the end surfaces
 - feature of figures 1 & 8
- wherein the LED is further visible from another end/side surface
 - feature of figure 1

Since the Seto reference teaches all of the functional equivalent claimed limitations, the claimed invention would have been anticipated the Seto reference.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 23 & 41, 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seto et al. (5,552,976) in view of Maddrell et al. (6,041,215) or Weber (4,056,701) or Wunsch et al. (4,454,596) or Hidaka (5,606,712).

i. The examiner relies on the examiner cited references as being the well known common knowledge in the art LED alert/display notification technique as stated above.

ii. The difference between the claimed invention and the teachings of the Seto reference is that the reference does not expressly disclose the exactly same physical shape of LED (i.e., physical situations of the LED) & the off button integration. However, such difference in limitation is a design choice matter to one having ordinary skill in the art. The examiner takes official notice on such design choice matter such as off button integration (e.g., as can be seen from the examiner cited references, Maddrell et al. (6,041,215) or Weber (4,056,701) or Wunsch et al. (4,454,596) or Hidaka (5,606,712), all teach the well known light emitting device & button combinations). This is because the physical situation of the LED is chosen by the designer with a motivation of choosing better visible location; one skilled artisan can easily choose a specific location or more than one locations to serve the purpose of alerting a user. Therefore, it would have been obvious at the time the invention was made to one having ordinary skill in the art to come up with the invention from the teachings of the Seto reference, for the reasons stated above.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. **Any Response To This Action Should Be Mailed To:**

If The Action Is Non-Final

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

or faxed to:

(703) 892-9306, (for formal communications intended for entry)

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Art Unit: 2182

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Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Any Other Telephone Communication Should Be Directed To

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Shin whose telephone number is (703) 305-9658. The examiner can normally be reached on Monday - Thursday from 7:00 AM to 4:00 PM.

Christopher B. Shin
January 14, 2004

Christopher B. Shin
PRIMARY EXAMINER
ART UNIT 2182

